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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/727,236 11/30/00 LINDERMAN

R 5051.509

EXAMINER

HM12/0925

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LUKTON, D.
ART UNIT

PAPER NUMBER

1653
DATE MAILED:

09/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/727,236

Applicant(s)
Linderman

Examiner
David Lukton

Art Unit
1653



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 17, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above, claim(s) 15-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

Applicants election of Group I (claims 1-14, drawn to a method of controlling a pest by administering a compound in which R_1 is $-NH_2$) is acknowledged, along with the elected specie (compound 3 on page 27). Claims 15-60 are withdrawn from consideration.

*

This application contains sequence disclosures that are encompassed by the definitions for amino acid sequences set forth in 37 CFR 1.821. However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 with regard to the sequence disclosures.

See, for example, the sequences on page 4, paragraph 2.

Applicant is given the time period set in this letter within which to comply with the sequence rules, 37 CFR 1.821-1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136. In no case may an applicant extend the period for response beyond the six month statutory period.

Also required is an amendment of the specification (at least on page 4) to recite SEQ ID numbers.

*

The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicants have proposed that the compounds (to which the claims are drawn) inhibit insect propagation by a process in which esterase biosynthesis is inhibited by a process which begins with stimulation of the TMOF receptor. However, there is no evidence that the TMOF receptor is affected one way or another by the compounds, or that esterase biosynthesis is affected one way or another by the compounds. In addition, it remains unknown at this time whether insect propagation is in any way altered. As it happens, receptor/ligand interactions are very specific, very exacting, and very "unpredictable". Accordingly, "undue experimentation" would be required to determine which, if any, of the claimed compounds can be used to inhibit esterase biosynthesis or to inhibit propagation of insects.

There is also the matter of "controlling" a pest. This term would encompass absolute, total elimination of 100% of all pests within a given area. For example, suppose that in a given field, there are 100,000 "pests" present, and suppose that one of the compounds is sprayed over the field, and 99,999 of the "pests" are killed, but one cockroach manages to survive, one could say that control had not been achieved. With respect to this secondary issue, it is suggested that applicants claim a method of inhibiting propagation, or some

equivalent phrase.

*

Claims 1-14 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1 is drawn to a method for "controlling" a pest. Which activities of a pest are being controlled? Is it their ability to fly, to crawl, to exhibit chemotaxis, to exhibit phototropism, to ingest food, to digest food, to reproduce, or some other activity?
- Claim 1 is indefinite with regard to what is intended by a "pest". The Stedman's Medical dictionary defines "pesticide" as an agent which destroys fungi, insects, rodents, or other pests. If applicants intend for the term "pest" to be limited to insects, it is suggested that the claim be so amended. If, on the other hand, applicants intend for the term at issue to include fungi and rodents, this should be made clear (new matter, of course, should be avoided).
- At the end of claim 1, the following phrase appears in two places:

"subject to the proviso that..."

However, the phrase "subject to" renders the claims indefinite as to whether the recited limitations are mandatory, or merely optional.

- Claim 1, second-to-last line makes reference to a variable "R". However, there is no variable "R" present in the formula.
- Claim 1 is indefinite as to the process steps and endpoint. In the event that applicants have shown that the compounds inhibit biosynthesis of a serine esterase, it is suggested that the claims be amended to recite that the time and conditions are indeed effective to accomplish this objective, i.e:

100. A method for inhibiting propagation of an insect comprising administering to said insect a compound of formula IA or formula IB

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*{formulas as recited}
for a time and under conditions effective to inhibit biosynthesis of a serine esterase...
[etc.]*

On the other hand, if applicants have shown that the compounds stimulate the TMOF receptor, it is suggested that the claims be amended to recite that the time and conditions are indeed effective to accomplish this objective, i.e:

*101. A method for inhibiting propagation of an insect comprising administering to said insect a compound of formual IA or formula IB
{formulas as recited} ~~the~~
for a time and under conditions effective to stimulate ~~the~~ trypsin modulating oostatic factor (TMOF) receptor...[etc.]*

*

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton. Phone: (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



DAVID LUKTON
PATENT EXAMINER
GROUP 1800